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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,312	07/10/2003	Pijush K. Dewanjee	PU2162	1311
23454	7590	12/09/2004	EXAMINER	
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328			PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/604,312	Applicant(s) DEWANJEE ET AL.	
	Examiner Sebastiano Passaniti	Art Unit 3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-10, 12-17 and 19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6 and 7 is/are allowed.
- 6) ☒ Claim(s) 8-10, 12-17 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office action is responsive to communication received 09/23/2004 – Amendment and Terminal Disclaimer.

At the outset, it is noted that the last Office action, mailed 09/20/2004, contained an inconsistency that may have led to some confusion during the drafting of applicant's response. For instance, the preamble of the first rejection applying Rowland in view of Hettinger and Gojny does not mention claim 9, yet the body of the rejection refers to a rejection of claim 9. Moreover, the limitations of claims 8 and 11 were inadvertently not treated except for a rejection based upon obviousness-type double patenting. Thus, the following non-final Office action is presented and includes a clarification of the rejections. Any inconvenience to the applicant is sincerely regretted.

The terminal disclaimer filed on 09/23/2004 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of 6,238,302 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Following is an action on the MERITS:

Claims 5, 11 and 18 have been canceled, as directed.

Claims 1-4, 6-10, 12-17 and 19 remain pending.

Claims 1-4, 6 and 7 are allowable over the prior art references of record, as none of the references of record show, suggest or otherwise render obvious the inclusion of a tab element having a straight and curved portion, as detailed by independent claim 1.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10, 12-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowland in view of Hettinger and Gojny. At the outset, it is noted that the filing date of the Rowland reference predates applicant's earliest priority date. Thus, the reference is available as prior art under §102(e) and therefore may be used under §103(a). The patent to Rowland shows every feature claimed with the exception of a composite polyurethane material for the striking face insert. Hettinger and Gojny show it to be old in the art to provide a composite insert for the striking face portion of a club head in order to provide additional energy to a struck ball. See col. 4, lines 45-55 in Hettinger. See col. 1, lines 35-46 and col. 2, lines 35-45 in Gojny. In view of the patents to Hettinger and Gojny, it would have been obvious to modify the device in the cited art reference to Rowland by replacing the insert with a material that is composed of thermoplastic polyurethane, the motivation being to alter the ball striking

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characteristics of the face. Moreover, it is noted that Rowland suggests that other materials may be used as part of the striking face in order to change the impact force as well as the corresponding trajectory and the amount of ball spin (col. 5, lines 14-20). As to claim 8, as the striking plate in Rowland may be fabricated from plastic material, it is clear that the tabs (52) are "compressible". Figure 16 in Rowland clearly shows the hemispherical shape of the tab body. As to claim 9, the insert in Rowland includes a trapezoidal shape. As to claim 10, see Figure 9 in Rowland showing the depth of the recess in the front of the striking face. As to claim 11, since adhesive or double-sided tape may be used to mount the insert (16) within the cavity in the body, it is clear that the depth of the recess must be greater, if only slightly, than the thickness of the insert so that the insert lies flush with the external striking surface of the club head body. As to claim 12, note again the language in col. 5, lines 20-33 in Rowland. As to claim 13, Figure 16 clearly shows a plurality of straight and curved portions. As to claims 14-17, the claimed limitations are not deemed critical. As to claim 19, the claimed thermoplastic polyurethane materials are merely examples of thermoplastic materials that are commonly available. Clearly, the applicant has not invented the claimed materials. The skilled artisan, being familiar with the characteristics of known materials, would have found it obvious to select a suitable thermoplastic based upon the specific ball response desired.

#### RESPONSE TO ARGUMENTS


Applicant's arguments with respect to claims 8-10, 12-17 and 19 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
December 7, 2004